

REMARKS

Introductory Comments

The Office Action rejects claims 1-12, 14-27, and 29-32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0114437 ("Nabkel") in view of U.S. Patent Publication No. 2003/0223403 ("Higgins") and U.S. Patent No. 6,044,403 ("Gerszberg") and further in view of U.S. Patent Publication No. 2004/0024754 ("Mane").

In this amendment, independent claims 1, 19, 25, 29, and 30 have been amended to include elements recited in claim 32, which has been canceled herein without prejudice or disclaimer. Claims 13 and 28 were previously canceled. New dependent claims 33-39 have been added. No new matter has been introduced. Consequently, claims 1-12, 14-27, 28-31, and 33-39 are pending in the application.

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The amendment does not raise new issues requiring further search or consideration. For example, the elements added to independent claims 1, 19, 25, 29, and 30 in this amendment have already been substantively examined as dependent claim 32 and do not introduce any new issues. Therefore, entry of the present amendment is proper under 37 C.F.R. § 1.116 and is hereby requested.

Applicants respectfully request reconsideration of the presently pending claims in light of the above amendments and the following remarks. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.

The Examiner's Failure to Address Several of Applicants' Arguments

In Applicants' previous amendment dated September 21, 2006, Applicants presented several arguments for the patentability of the claims. Although the Examiner has introduced the Mane reference into the rejections of all of the claims, the Office Action applies teachings of Mane only to certain elements of independent claims 1, 19, 25, 29, and 30 without addressing all of Applicants' arguments for the patentability of the claims. For example, the Office Action does not address Applicants' arguments against the asserted combination of Gerszberg with Nabkel and Higgins set forth in the Office Action of June 29, 2006. See Applicants' amendment

of September 21, 2006, pages 14 and 15. The same arguments apply equally to the asserted combination of Gerszberg with Nabkel, Higgins, and Mane as set forth in the current Office Action. The current Office Action also fails to substantively address Applicants' arguments for the patentability of dependent claims 3 and 9 as set forth on pages 15 and 16 of Applicants' amendment of September 21, 2006. Accordingly, in addition to the new arguments for the patentability of the claims set forth below, Applicants maintain the arguments against the asserted combination of Gerszberg with Nabkel, Higgins as applied now to the combination of Gerszberg with Nabkel, Higgins, and Mane and against the reasoning relied upon to reject claims 3 and 9. Should the Examiner continue to rely upon the same reasons to reject these claims, Applicants respectfully request that the Examiner respond to the substance of the arguments presented herein for the patentability of the claims so that Applicants may know how to best respond.

Rejection of Claims 1-12, 14-27, and 29-32 under 35 U.S.C. §103(a)

On page 2 of the Office Action, the Examiner rejected claims 1-12, 14-27, and 29-32 under 35 U.S.C. §103(a) as being unpatentable over Nabkel in view of Higgins and Gerszberg and further in view of Mane. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01. Thus, a *prima facie* case of obviousness requires: (1) a suggestion or motivation to modify or combine the reference teachings; (2) a reasonable expectation of success; and (3) a teaching or suggestion in the prior art references of all of the claim elements (MPEP 2143). For the following reasons, Applicants respectfully traverse the rejection of claims 1-12, 14-27, and 29-31. Claim 32 has been canceled herein. Therefore, its rejection is obviated.

A. Independent Claims 1, 19, 25, 29, and 30

As amended, independent claims 1, 19, 25, 29, and 30 each recite claim elements that are not taught or suggested in Nabkel, Higgins, Gerszberg, Mane, or the asserted combination thereof. Independent claim 1 now recites:

1. A telephony system, comprising:
a service node configured to communicate with a user device and provide a user associated with the user device with an automated voice interface to the telephony system upon the user's initiating access to the telephony system via the user device,
wherein the automated voice interface is configured to permit the user to verbally specify a desired objective corresponding to any one of a plurality of predefined objectives, the predefined objectives including directory assisted call placement and at least one form of information retrieval,
and wherein, upon receiving the desired objective from the user, the service node acts to implement the desired objective, wherein when the user specifies a desired objective relating to information retrieval, the service node is configured to:
request, by voiced instruction, the user's verbal specification of an information item,
retrieve the verbally specified information item from an information source, and
voice the information item to the user via the user device,
and wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the service node is configured to request, by voiced instruction, the user's verbal specification of a preferred Internet search engine.

(Emphasis added.)

Independent claim 19 now recites:

19. A service node for use in a telephony system including a switch, the switch providing system access for a user device, the service node comprising:
logic configured to communicate, via the switch, with the user device and to provide a user of the telephony system with an automated voice interface upon the user's initiating access to the telephony system via the user device,
wherein the automated voice interface is configured to permit the user to verbally specify a desired objective corresponding to any one of a plurality of predefined objectives, the predefined objectives including call placement and at least one form of information retrieval,
and wherein, upon receiving the desired objective from the user, the service node acts to implement the desired objective, wherein when the user

specifies a desired objective relating to information retrieval, the service node is configured to:

request, by voiced instruction, the user's verbal specification of an information item,

retrieve the verbally specified information item from an information source, and

voice the information item to the user via the user device,

and wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the service node is configured to request, by voiced instruction, the user's verbal specification of a preferred Internet search engine.

(Emphasis added.)

Independent claim 25 now recites:

25. A method of providing a user of a telephony system with an automated voice interface, comprising:

voicing a request to the user, upon the user's initiating access to the telephony system, that the user identify an intended objective;

awaiting the user's response to the voiced request;

selecting, based upon the user's response, one of a plurality of predefined objectives, the predefined objectives including directory assisted call placement and at least one form of information retrieval; and

acting to implement the selected objective, wherein, when the selected objective is a form of information retrieval, the acting to implement the objective comprises:

requesting, by voiced instruction, the user's verbal specification of an information item,

retrieving the verbally specified information item from an information source, and

voicing the retrieved information item to the user;

and wherein when the selected objective relates to information retrieval by retrieval of Internet search results, the acting to implement the objective comprises requesting, by voiced instruction, the user's verbal specification of a preferred Internet search engine.

(Emphasis added.)

Independent claim 29 now recites:

29. A telephony system, comprising:

means for detecting a user's initiating access to the telephony system;

means for soliciting, upon the user's initiating access to the system, the user's verbal specification of one of a plurality of predefined objectives, the predefined objectives including directory assisted call placement and at least one form of information retrieval; and

means for implementing the verbally specified objective, wherein when the user specifies a desired objective relating to information retrieval, the implementing includes:

requesting, by voiced instruction, the user's verbal specification of an information item,

retrieving the verbally specified information item from an information source, and

voicing the retrieved information item to the user;

and wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the implementing includes requesting, by voiced instruction, the user's verbal specification of a preferred Internet search engine.

(Emphasis added.)

Independent claim 30 now recites:

30. A computer-readable medium including a plurality of instructions that, when executed by a service node in a telephony system, cause the service node to function as an automated telephone attendant, the computer-readable medium comprising:

instructions for voicing a request to a telephone user that the user state an intended objective;

instructions for selecting, based upon the user's stated objective, one of a plurality of predefined objectives, the predefined objectives including directory assisted call placement and at least one form of information retrieval; and

instructions for acting to implement the selected objective, wherein when the selected objective relates to information retrieval, the acting to implement includes:

requesting, by voiced instruction, the user's verbal specification of an information item,

retrieving the verbally specified information item from an information source, and

voicing the retrieved information item to the user;

and wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the acting to implement includes requesting, by voiced instruction, the user's verbal specification of a preferred Internet search engine.

(Emphasis added.)

The amendments to the claims are fully supported by the specification. For example, Applicants' specification at paragraph 0041 states:

[0041] Once the user's objective is determined, VASN 180 may, if necessary, voice additional instructions to the user in order to solicit the user's spoken refinement of his or her intent. For example, if VASN 180 determines that the user wants directory assisted call placement, VASN 180 may voice a request for the geographic location (e.g., city and state) and identity (e.g., given name and surname) of the destination the user wishes to reach. Or, as another example, if VASN 180 determines that the user wishes to perform an Internet search, VASN 180 may voice a request for search terms and, optionally, a preferred search engine. As a further example, if VASN 180 determines that the user wishes to retrieve e-mail messages, VASN 180 may request the user's account information, service provider information, etc.

The cited prior art references, taken alone or together, do not teach or suggest each and every element of the amended independent claims, including claim elements directed to "wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the service node is configured to request, by voiced instruction, the user's verbal specification of a preferred Internet search engine."¹ Emphasis added. Because the amendments to claims 1, 19, 25, 29, and 30 are based at least in part on elements recited in now canceled claim 32, the rejection of claim 32 is relevant. In rejecting claim 32 on page 4 of the Office Action, the Examiner points to paragraph 0018 of Mane, which states:

[00 18] In embodiments of the present invention, the recognizer 120 may include and/or may operate in conjunction with, for example, an Internet search engine that receives text, speech, etc. from an Internet user. In this case, the recognizer 120 may receive user's communication via an Internet connection and operate in accordance with embodiments of the invention as described herein.

(Emphasis added.)

The cited paragraph simply mentions that the recognizer 120 of Mane may include and/or operate in conjunction with an Internet search engine, but there is no teaching or suggestion of requesting by voiced instruction that a user specify a preferred Internet search engine. In contrast, Mane's disclosure of "an Internet search engine" in paragraph 0018 at the very least implies using a single pre-selected Internet search engine and teaches away from a user being provided with an opportunity to specify a preferred Internet search engine. According, a user of

¹ This language appears verbatim in claims 1 and 19. With respect to claims 25, 29, and 30, while the language is somewhat different, the same arguments are equally applicable.

the system of Mane would be limited to using the pre-selected Internet search engine. For at least these reasons, the relied upon section of Mane fails to teach or suggest "wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the service node is configured to request, by voiced instruction, the user's verbal specification of a preferred Internet search engine," as recited, or substantially recited, in claims 1, 19, 25, 29, and 30.

Nabkel, Higgins, and Gerszberg do not cure, nor does the Office Action allege that these references cure, the above-described deficiencies of Mane. Therefore, the asserted combination of Nabkel, Higgins, Gerszberg, and Mane fails to teach or suggest "wherein when the user specifies the desired objective relating to information retrieval by retrieval of Internet search results, the service node is configured to request, by voiced instruction, the user's verbal specification of a preferred Internet search engine," as recited, or substantially recited, in claims 1, 19, 25, 29, and 30. Accordingly, Nabkel, Higgins, Gerszberg, and Mane taken alone or in combination, do not teach or suggest each and every element recited in claims 1, 19, 25, 29, and 30 as amended, and Applicants respectfully traverse the §103 rejection of these claims.

The Office Action fails to establish a *prima facie* case of obviousness against claims 1, 19, 25, 29, and 30 for a separate reason: one of ordinary skill in the art would not have been motivated to combine Gerszberg with Nabkel, Higgins, and Mane as asserted in the Office Action. Even if one service platform could be substituted for another service platform as alleged on page 3 of the Office Action, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. Further, a reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Gerszberg is directed to a network server platform for Internet, Java server, and video application server. Gerszberg, Title and Abstract. As described above, the platform of Gerszberg relies upon visual displays and the selection of visually displayed indicators to access services and, as a visually-based system, the system of Gerszberg teaches away from the asserted substitution of the platform of Gerszberg for the service platform of Nabkel and Higgins, which disclose the use of non-visual communications to access information

services. Nabkel, para. 0025; Higgins, Abstract.

In addition, the substitution of the visual interface of Gerszberg for the voice interface of Nabkel and Higgins would impermissibly modify the principles of Nabkel and Higgins by eliminating their voice-based platforms. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02. For the above-described reasons, one of ordinary skill in the art would not have been motivated to combine Gerszberg with Nabkel, Higgins, and Mane as asserted in the Office Action. Without Gerszberg, the Office Action does not establish a *prima facie* case of obviousness against the claims.

For any of the foregoing reasons, Applicants respectfully traverse the rejection of independent claims 1, 19, 25, 29, and 30. Therefore, the rejection of these claims should be withdrawn and the claims allowed.

B. The Dependent Claims Recite Patentable Subject Matter

For the same reasons described above, dependent claims 2-12, 14-18, 20-24, 26, 27, and 31 are in condition for allowance as claims depending directly or indirectly from independent claim 1, 19, or 25. The dependent claims also recite independently patentable subject matter not taught or suggested in Nabkel, Higgins, Gerszberg, Mane, or the combination thereof. Merely by way of example, claim 3 recites:

3. The telephony system according to claim 1, wherein the user device is a wireless telephone, and wherein the user initiates access to the telephony system by dialing a predefined key sequence.

According to the Office Action, the elements recited in claim 3 "would be inherent in a wireless system and it would have been obvious to one of ordinary skill to migrate that which is known in wireline to wireless." Office Action, page 3. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (citations omitted). The Office Action does not provide

sufficient evidence that a user initiating access to the telephony system by dialing a predefined key sequence would be necessarily present in Nabkel, Higgins, Gerszberg, Mane, or the combination thereof. If the Examiner continues to rely upon inherency to reject claim 3, Applicants respectfully repeat their request that the Examiner expressly point out how initiating access to the telephony system by dialing a predefined key sequence is necessarily present in the prior art of record. Because these elements are not necessarily present in the prior art of record, the rejection of claim 3 should be withdrawn.

By way of another example, claim 9 recites:

9. The telephony system according to claim 8, wherein the service control point is further configured to verify a voice interface service subscription for the user device prior to setting up a communication channel between the service node and the switch.

According to the Office Action, the elements recited in claim 9 “would be inherent unless the service is free which is not the way business is done.” Office Action, page 3. However, there is no teaching or suggestion in Nabkel, Higgins, Gerszberg, or Mane of their respective systems being limited to subscribers. It would be entirely possible for the systems of Nabkel, Higgins, Gerszberg, or Mane to provide services for free or charge for each discrete use of the services (e.g., a fee for each instance of directory assistance service). Therefore, the reasoning presented in the Office Action does not show that verifying a voice interface service subscription as recited in claim 9 would be necessarily present in Nabkel, Higgins, Gerszberg, Mane, or the combination thereof. Therefore, the rejection of claim 9 should be withdrawn.

New Claims 33-39

Applicants have added new dependent claims 33-39, each of which depends either directly or indirectly from independent claim 1. The newly added claims are fully supported by Applicants’ specification. For example, see Figures 1-4 (especially Figures 3 and 4) of Applicants’ drawings and paragraphs 0045 and 0050-0056 of Applicants’ specification.

The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims. The new claims also recite independently patentable subject matter. Therefore, examination and allowance of the newly added claims is respectfully requested.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0378. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Respectfully submitted,

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